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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,815	03/18/2004	Takanori Kurokawa	07057.0073-00	5868

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EXAMINER

LE, HUNG CHARLIE

ART UNIT	PAPER NUMBER
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3663

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/19/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/802,815	KUROKAWA ET AL.	
	Examiner	Art Unit	
	Hung C. Le	3663	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3 - 5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3 - 5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/01/2007 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
3. Claim 1 (claim 2 was cancelled by applicant) is rejected under 35 U.S.C. 103(a) as being unpatentable over Munz et al. (DE 19938452 A1) in view of Komatsubara et al. (6,136,456). Munz et al. discloses applicant's claim limitation except for surface roughness and height of roughness for steel (metal) which is

taught by Komatsubara et al. (Komatsubara et al.: claims 6 & 7).

With respect to claim 1:

Munz et al. discloses: A press molding die, comprising:

a punch (10) which presses a workpiece (20);

a molding die (14) having a molding surface on which the workpiece (20) is placed and a concave portion which is formed on the molding surface and which has a shape corresponding to the punch (see Fig. 1);

a pad (6) which presses a portion that is a part of the workpiece (20) placed on the molding surface and that is on a periphery of the concave portion; and

a micro-rough layer (18) having a thickness of 10 to 15 μm (page 3, line 12), a hardness of over 70 Rockwell (see Page 3, lines 16), which is formed by performing a particulate coating process (see Munz et al.'s claim 1) on at least one of a portion of the pad, for pressing the workpiece (20), and a portion of the molding surface, corresponding to the portion of the pad (6).

While patent drawings are not drawn to scale, relationships clearly shown in the drawings of a reference patent cannot be disregarded in determining the patentability of claims. See In re Mraz, 59 CCPA 866, 455 F.2d 1069, 173 USPQ 25 (1972).

It would have been obvious to one having ordinary skill in the art at the time the

invention was made to vary the particle diameter [Munz's chrome surface coating also has a micro-rough surface structure(Munz's claim 5) obviously having a certain particle diameter] within the range suggested by applicant to achieve a desired result. It is well-settled that optimizing a result effective variable is well within the expected ability of a person of ordinary skill in the subject art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980), In re Aller, 220 F.2d 454, 105 USPQ 233 (CCPA 1955).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the press molding die as disclosed by Munz et al. with the teaching of Komatsubara et al. for economical and stability control advantages as such modification is no more than the work of an expedient within the art.

4. Claims 3 - 5 (claim 2 was cancelled by applicant) are rejected under 35 U.S.C. 103(a) as being unpatentable over Munz et al. (DE 19938452 A1) in view of Komatsubara et al. (6,136,456) as applied to claim 1 above, and further in view of Akira Uchiyama (EP 58123896), Toda Kazuo (EP 54071048) as applied to claims 3 & 4 and Iwaya (6,807,838) as applied to claim 5. Munz et al. in view of Komatsubara et al. disclose applicant's claim limitation except for plating solution and its specific chemical compositions which are taught by Uchiyama and Kazuo and plurality of grooves which are taught by Iwaya.

With respect to claim 3 & 4:

Munz et al. further disclose: The form tool is provided with a surface coating of a material containing Chrome applied to the Zamak material (a fine zinc alloy) (see Munz: claim 1). Munz's coating surface is applied using galvanic means.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the coating process as disclosed by Munz et al. in view of Komatsubara et al. with the teachings of Uchiyama and Kazuo for abrasive resistance, corrosion resistance and adhesion advantages as such modification is no more than the work of an expedient within the art.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to vary the solution composition and the composition of the micro-rough layer within the range suggested by the applicant to achieve a desired result. It is well-settled that optimizing a result effective variable is well within the expected ability of a person of ordinary skill in the subject art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980), In re Aller, 220 F.2d 454, 105 USPQ 233 (CCPA 1955).

With respect to claim 5:

It would have been obvious to one having ordinary skill in the art at the time the

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invention was made to modify the press molding die as disclosed by Munz et al. in view of Komatsubara et al. with the teaching of Iwaya for effective in reducing sliding resistance advantages (Iwaya: Col. 2, lines 13+).

5. The statements of intended use or field of use, e.g., "having, by performing, for pressing, is performed, are formed, wherein, etc..." clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See In re Pearson, 181 USPQ 641; In re Yanush, 177 USPQ 705; In re Finsterwalder, 168 USPQ 530; In re Casey, 512 USPQ 235; In re Otto, 136 USPQ 458; Ex parte Masham, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. In re Danly, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung C. Le whose telephone number is 571-272-8757. The examiner can normally be reached on M-F: 07:30am - 05:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack W. Keith can be reached on 571-272-6878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HCL
04/09/07


JACK KEITH
SUPERVISORY PATENT EXAMINER